

REMARKS

In the outstanding Office Action¹, the Examiner took the following actions:

- 1) rejected claims 1, 7, 9, 15, 17, 23, 25-34, and 36-37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,177,932 to Galdes et al. ("Galdes"); and
- 2) rejected claims 8, 16, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Galdes in view of U.S. Patent No. 5,594,791 to Szlam et al. ("Szlam").

By this Amendment, Applicant amends claims 1, 9, 17, 25-31, 34 and adds new claims 38-40. Claims 1, 7-9, 15-17, 23-34, and 36-40 remain pending in this application

I. Rejection under 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 1, 7, 9, 15, 17, 23, 25-34, and 36-37 under 35 U.S.C. § 102(e) as being anticipated by Galdes. In order to properly establish that Galdes anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, "either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th Ed., Rev. 6 (Sept. 2007).

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

Galdes cannot anticipate claims 1, 7, 9, 15, 17, 23, 25-34, and 36-37 because Galdes fails to disclose each and every element recited in the claims.

For example, Galdes fails to disclose a method for providing real-time counseling service by using a network comprising, among other things, "the identification code including at least one selected from the group consisting of query-contents identification, language information, a service-providing server information, and the user's location information" as recited in amended independent claims 1, 9, 17, and 25-31 and similarly recited in claim 34. In the Office Action, the Examiner asserts "[a]lthough there is no explicit reference to an ID code, the category data is clearly encoded in the help request in some fashion or else it would not be possible to direct the help request to appropriate counselors *based on the area of the help request.*" Applicant disagrees with the Examiner's assertions. The identification code of the Applicant's invention is generated from click information corresponding to a counseling link whereas Galdes discloses counseling information provided to an advisor. Accordingly, Galdes clearly fails to disclose this feature.

Further to the extent that the Examiner is insisting that this feature is inherent in Galdes, inherency is not appropriate here as according to MPEP §2112, "the examiner must provide rationale or evidence tending to show inherency" such that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of the result or characteristic. *In re Rijckaert*, 9F3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993). Further, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by a

person of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The claimed “identification” code consistent with Applicant’s claimed invention is a connector between a user and a counselor. That is, when the user selects a counseling link on a webpage, an identification code corresponding to the counseling link may be generated. Then, the identification code maps a particular counselor group, which is pre-configured in, for example, a table, with the user. Also, as is recited in amended claim 1, the identification code may be selected from a group consisting of query-contents identification, language information, a service-providing server information, and the user’s location information. Regarding the generation of an identification code based on the category of the query, the Examiner points to col. 8, lines 55-58 which discloses that “help requests may be allocated based on the advisor’s level of knowledge in the area of the help request.” Thus, Galdes does not disclose “generating an identification code in accordance with the click information,” as recited in claims 1, 9, 17 and 25-31. Therefore, for at least the reasons mentioned above, Galdes fails to disclose a method for providing real-time counseling service by using a network comprising, among other things, “the identification code including at least one selected from the group consisting of query-contents identification, language information, a service-providing server’s information, and the user’s location information” as recited in amended claims 1, 9, 17, and 25-31 and similarly recited in amended claim 34.

Because Galdes fails to disclose each and every element as recited in amended claims 1, 9, 17, 25-31, and 34, those claims are allowable over Galdes. Moreover, dependent claims 7, 15, 23, 32-33, and 36-37 are allowable at least due to their dependence from allowable claims 1, 9, 17, 25-31, and 34. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 1, 7, 9, 15, 17, 23, 25-34, and 36-37 under 35 U.S.C. § 102(e).

II. Rejection under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 8, 16, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Galdes in view of Szlam. No *prima facie* case of obviousness is established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. MPEP § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." MPEP § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. MPEP § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have

been obvious, but whether the claimed invention as a whole would have been obvious."
MPEP § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." MPEP § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." MPEP § 2141(III).

In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 8 is dependent on claim 1 or 7, claim 16 is dependent on claim 9 or 15, and claim 24 is dependent on claim 17 or 23 and therefore requires the limitations of one of the independent claims. Therefore, claims 8, 16, and 24 require "the identification code including at least one selected from the group consisting of query-contents identification, language information, a service-providing server's information, and the user's location information," as recited in amended claims 1, 9, and 17. As mentioned previously, Galdes fails to disclose this feature.

The Examiner asserts that "Galdes fails to teach of providing advertisement in the chat room," but relied on Szlam in asserting, "Szlam teaches of providing advertisements within a customer service setting." Office Action at 4. Even assuming the Examiner's characterization of Szlam is correct, which Applicant does not concede, Szlam fails to cure the deficiencies of Galdes discussed above. That is, Szlam also fails to teach or suggest a method, comprising, "the identification code including at least one selected from the group consisting of query-contents identification, language information, a service-providing server's information, and the user's location information," as recited in claims 1, 9, and 17 and required by claims 8, 16, and 24 respectively.

However, the Examiner's reason for rejection is improper as claims 8, 16, and 24 do not recite "providing advertisement in the chat room" but rather that "the counseling room is a chat room, and [that] the user can carry on an electronic business (e-business) by using URLs of electronic business malls that are provided in the chat room." Szlam does not teach or suggest at least this recited element.

For at least the reasons presented above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established for claims 8, 16, and 24. Claims 8, 16, and 24 are thus allowable over Galdes and Szlam.

Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 8, 16, and 24 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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